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09/844,322	04/26/2001	Casey William Norman	1391-CON-00	1969

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EXAMINER

FRANCIS, FAYE

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 09/24/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,322

Applicant(s)

NORMAN ET AL.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 and 25-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 25-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching of a seamless doll's garment and that the doll's garment has a molded shape to fit over at least a portion of a doll as now recited in claims 21-22 and 47, 38, 44 and 47, the injection molded thermoplastic elastomer is colorless as recited in claim 27. Additionally, proper antecedent basis should be provided in the specification for the teaching of the average modulus of elasticity is less than 1 MN/M^2 as recited in claims 22, 30 and 47, the doll is articulated at a joint selected from the group consisting of neck, and hips as recited in claims 34 and 38, the 100% modulus of elasticity is between 240 and 280 KN/M^2 as recited in claims 31, 42 and 51. Also, proper antecedent basis should be provided in the specification for the teaching of the 300% modulus of elasticity is between 440 and 490 KN/M^2 as recited in claims 32 and 43 and 100% modulus of elasticity is between 120 and 350 KN/M^2 as recited in claim 50. No new matter should be entered into the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 31-32, 41-43 and 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear what the applicant refers as 100% or 300% modulus of elasticity.

4. Claims 21-22, 27, 30-32, 41-43, 47 and 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the teaching of “a seamless injection molded thermoplastic elastomer doll's garment” as now recited in claims 21 and 22. The specification also does not provide support the limitation “the average modulus of elasticity is less than 1 MN/M²” as recited in claims 22, 30 and 47, “the injection molded thermoplastic elastomer is colorless” as recited in claim 27, “the 100% modulus of elasticity is between 240 and 280 KN/M²” as recited in claims 31, 42 and 51. Additionally, the specification does not provide support the limitation “the doll is articulated at a joint selected from the group consisting of neck, and hips” as recited in claims 34 and 38.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21-23, 25-28, 30-33 rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian et al, hereinafter O'Brian.

Kramer discloses most of the elements of these claims including a doll, a doll's garment [col 1 lines 51-57] formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch [less than 1 MN/M²].

Kramer does not disclose a seamless, colorless injection molded thermoplastic elastomer doll's garment as recited in claims 21-22, a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 26 and the garment is less than 8 cm in height as recited in claim 28.

O'Brian in at least some of the embodiment such as Figs 2 and 3 teaches the concept of providing seamless [col 2 lines 38-53] injection molded thermoplastic elastomer [col 3 lines 54-56] doll's garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of the seamless injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

With respect to claim 26: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the O'Brian's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice. Also it would have been obvious to make the material colorless in order to make it more fun to play with.

With respect to claim 28, it would have been obvious to further provide the garment of O'Brian in the claimed height for the purpose of making the devices easier to play with and to accommodate for small dolls.

7. Claims 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian as applied to claims 21-23, 25-28, 30-33 and further in view of Yasuda.

Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene [col 3 lines 18-54] in order to make clothes for dolls [as the constituent element of dolls]. It would have been obvious to make the modified device of Kramer out of thermoplastic elastomer containing styrene as taught by Yasuda in order to give the device more flexibility.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian and further in view of Gross.

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Modified device of Kramer discloses most of the elements of these claims, but does not disclose a play set comprising a doll wherein the doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips.

Gross is cited to show a desirability to have a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees. It would have been obvious to further provide the modified device of Kramer with the articulated doll as disclosed by Gross, for the purpose of making the device more enjoyable for the children to play with.

9. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian, Gross and further in view of Yasuda.

Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene [col 3 lines 18-54] in order to make clothes for dolls [as the constituent element of dolls]. It would have been obvious to make the modified device of Kramer out of thermoplastic elastomer containing styrene as taught by Yasuda in order to give the device more flexibility.

10. Claims 38-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian, Yasuda and Gross.

Kramer discloses most of the elements of these claims including a doll, a doll's garment [col 1 lines 51-57] formed from a flexible sheet of polymer plastic material

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between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch [less than 1 MN/M²].

Kramer does not disclose a seamless, colorless injection molded thermoplastic elastomer doll's garment, the specific thermoplastic elastomer material, a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees as recited in claims 38 and 47. Additionally, Kramer does not disclose a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 46.

O'Brian in at least some of the embodiment such as Figs 2 and 3 teaches the concept of providing seamless [col 2 lines 38-53] injection molded thermoplastic elastomer [col 3 lines 54-56] doll's garment. It would have been obvious to use the teaching of the seamless injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

Yasuda discloses using the thermoplastic elastomer containing styrene [col 3 lines 18-54] in order to make clothes for dolls [as the constituent element of dolls]. It would have been obvious to further make the device of Kramer out of thermoplastic elastomer containing styrene as taught by Yasuda in order to give the device more flexibility.

With respect to claim 46: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the Kramer's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

Gross is cited to show a desirability to have a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees. It would have been obvious to further provide the device of Kramer with the articulated doll as disclosed by Gross, for the purpose of making the device more enjoyable for the children to play with.

Response to Arguments

11. Applicant's arguments with respect to claims 20-23 and 25-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF


Jacob K. Ackun
Primary Examiner